



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,820	11/13/2001	William George Alton	287108-00001	5667
7590	09/01/2005			EXAMINER
David C. Jenkins Eckert Seamans Cherin & Mellott, LLC 44th Floor 600 Grant Street Pittsburgh, PA 15219			PRONE, JASON D	
			ART UNIT	PAPER NUMBER
			3724	
			DATE MAILED: 09/01/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/008,820	ALTON, WILLIAM GEORGE	
	Examiner	Art Unit	
	Jason Prone	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 June 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-12 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-12 and 15-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. It is noted that the examiner has rejoined claims 6-12 with the previously elected claims. However, claims 13 and 14 have not been rejoined. The subject matter of now cancelled claim 2, that has been added to claim 1, corresponds to the elected species (Figs. 4B, 5B, and 6B). The addition of this subject matter into claim 1, no longer allows claim 1 to be generic towards claim 13 and, therefore, claim 13 along with dependant 14 have not been rejoined. See the rejection below for more details.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-12, and 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In regards to claim 1, the phrase "each tooth in a group having a cutting extension" is unclear. It is unclear if the terms "group" and "cutting extension" are the same structure as the previously disclosed group and extension. It is noted that the phrase should be replaced with "each tooth in said groups having said cutting extension".

5. In regards to claim 5, the phrase "each said group of teeth includes a plurality of teeth" appears to be redundant. Claim 1 discloses "a plurality of unset teeth" and "said

teeth are disposed...in groups". Claim 5 appears to be restating what claim 1 has already disclosed.

Next, in Claim 5, the phrase "each said cutting tooth having a cutting extension" appears to also be redundant. Claim 1 discloses "each tooth in a group having a cutting extension". If claim 5 is not redundant, it is unclear if the structure of the cutting extension, of claim 5, is the same as the cutting extension structure of claim 1.

Finally, in regards to claim 5, the phrase "each cutting extension having a width that is about equal to the width of the tooth body divided by the number of cutting teeth in the group" appears to be redundant. Claim 1 discloses "wherein within each said group, the sum of the widths of said cutting extensions is about equal to the width of the teeth bodies". The phrase from claim 5 appears to be restating what claim 1 has already disclosed.

It is noted that claim 5 should be cancelled.

6. In regards to claim 6, the phrase "each said cutting tooth having a cutting extension" is unclear. Claim 1 discloses "each tooth in a group having a cutting extension". It is unclear if the structure of the cutting extension, of claim 6, is the same as the cutting extension structure of claim 1.

7. In regards to claim 8, the phrase "each said cutting tooth having a cutting extension" is unclear. Claim 1 discloses "each tooth in a group having a cutting extension". It is unclear if the structure of the cutting extension, of claim 8, is the same as the cutting extension structure of claim 1.

8. In regards to claim 10, the phrase "each said cutting tooth having a cutting extension" is unclear. Claim 1 discloses "each tooth in a group having a cutting extension". It is unclear if the structure of the cutting extension, of claim 10, is the same as the cutting extension structure of claim 1.

9. In regards to claim 12, the phrase "each said group of teeth includes a plurality of teeth" appears to be redundant. Claim 1 discloses "a plurality of unset teeth" and "said teeth are disposed...in groups". Claim 12 appears to be restating what claim 1 has already disclosed.

Next, in Claim 12, the phrase "each said cutting tooth having one or more cutting extension" is unclear. Claim 1 now discloses "each tooth in a group having a cutting extension". This phrase corresponds with Figures 4-6 (specifically the elected species of Figures 4B, 5B, and 6B). It is unclear how the apparatuses shown in Figures 4-6 can incorporate the structure of having more cutting extensions. When the subject matter of cancelled claim 2 was added to claim 1, claim 1 was no longer generic to the species of Figures 7 and 8. Since claim 1 incorporates specific subject matter pertaining to Figures 4-6 (specifically elected species Figures 4B, 5B, and 6B) and the specification and the Figures do not support the apparatuses from these Figures with "more extensions", it is not clear how the "more extension" structure is incorporated into the invention.

Finally, in regards to claim 12, the final paragraph, lines 4-6, appears to be redundant. Claim 1 discloses "wherein within each said group, the sum of the widths of

said cutting extensions is about equal to the width of the teeth bodies". The phrase from claim 12 appears to be restating what claim 1 has already disclosed.

10. In regards to claim 15, the phrase "said each groups comprise a plurality of teeth" appears to be redundant. Claim 1 discloses "a plurality of unset teeth" and "said teeth are disposed...in groups". Claim 15 appears to be restating what claim 1 has already disclosed.

11. In regards to claim 18, the phrase "each said group of teeth includes a plurality of teeth" appears to be redundant. Claim 1 discloses "a plurality of unset teeth" and "said teeth are disposed...in groups". Claim 18 appears to be restating what claim 1 has already disclosed.

Next, in Claim 18, the phrase "each said cutting tooth having one or more cutting extension" is unclear. Claim 1 now discloses "each tooth in a group having a cutting extension". This phrase corresponds with Figures 4-6 (specifically the elected species of Figures 4B, 5B, and 6B). It is unclear how the apparatuses shown in Figures 4-6 can incorporate the structure of having more cutting extensions. When the subject matter of cancelled claim 2 was added to claim 1, claim 1 was no longer generic to the species of Figures 7 and 8. Since claim 1 incorporates specific subject matter pertaining to Figures 4-6 (specifically elected species Figures 4B, 5B, and 6B) and the specification and the Figures do not support the apparatuses from these Figures with "more extensions", it is not clear how the "more extension" structure is incorporated into the invention.

Finally, in regards to claim 18, the final paragraph, lines 4-6, appears to be redundant. Claim 1 discloses "wherein within each said group, the sum of the widths of said cutting extensions is about equal to the width of the teeth bodies". The phrase from claim 18 appears to be restating what claim 1 has already disclosed.

Allowable Subject Matter

12. Claims 1, 3-11, 15-17, and 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Response to Arguments

13. Upon further review, issues under 112 second paragraph have come to the attention of the examiner. The examiner apologizes for the additional action but found that the 112 issues would be easier resolved if read in an Office action. It is noted that due to claim 1 disclosing subject matter pertaining to Figures 4-6 and no longer being a generic claim to claims with subject matter pertaining to Figures 7 and 8, that all claims with subject matter dealing with Figures 7 and 8 (claims 12-14 and 18) should be cancelled.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP
August 30, 2005

slc
STEPHEN CHOI
PRIMARY EXAMINER